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| APPLICATION NO.                 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 09/730,131                      | 12/05/2000  | Harold A. Ewing      | QMI385/99878A       | 7857             |
| 43167                           | 7590        | 08/29/2005           | EXAMINER            |                  |
| WINSTEAD SECHREST & MINICK P.C. |             |                      | DEXTER, CLARK F     |                  |
| PO BOX 50784                    |             |                      | ART UNIT            |                  |
| DALLAS, TX 75201                |             |                      | PAPER NUMBER        |                  |

3724

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/730,131

Applicant(s)

EWING ET AL.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The amendment filed on August 3, 2004 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al., pn 5,437,828 in view of Goldman, pn 3,299,761.

Shimizu discloses an apparatus with almost every structural limitation of the claimed invention including a framework; at least one roller (e.g., 30a); an optical

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encoder (e.g., see col. 5, lines 30-35); at least one punch assembly (e.g., 53a,54a; 53b,54b; 55a,56a; 55b,56b); at least one solenoid valve (e.g., see col. 5, lines 8-12, 22-28); and a computer (e.g., see col. 6, lines 3-5). Shimizu lacks (a) a compressed air source connected to the solenoid valve; and (b) the punch assembly containing a steel ball.

Regarding (a), the Examiner takes Official notice that it is old and well known in the art to provide a compressed air source for a solenoid valve for various well known benefits including facilitating the operation of the solenoid. One example of such a punch structure is disclosed by Goldman (see col. 4, line 1). Therefore, it would have been obvious to one having ordinary skill in the art to provide a compressed air source connected to the solenoid valve of Shimizu for the well known benefits including that described above.

Regarding (b), the Examiner takes Official notice that such punch structures are old and well known in the art and provide various well known benefits including providing a punch structure that is relatively inexpensive to manufacture and is capable of giving long trouble-free service. One example of such a punch structure is disclosed by Goldman. Therefore, it would have been obvious to one having ordinary skill in the art to provide a punch assembly containing a steel ball on the apparatus of Shimizu for the well known benefits including those described above.

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4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman, pn 3,299,761.

Goldman discloses an apparatus with almost every structural limitation of the claimed invention including a framework (e.g., 10); at least one punch assembly (e.g., 40, 246); at least one solenoid valve (e.g., 138, 310); at least one compressed air source (e.g., see col. 4, line 1). Goldman lacks an automated workpiece feeding configuration including a roller, an optical encoder, and a computer. However, the Examiner takes Official notice that such automated workpiece feeding configurations are old and well known in the art and provide well known benefits including providing automatic operation of an apparatus based on an amount of workpiece material fed through the apparatus. Willits et al., pn 4,809,188 and Shimizu et al., pn 5,437,828 are provided as just two examples of such an automated workpiece feeding configuration. Therefore, it would have been obvious to one having ordinary skill in the art to provide such an automated workpiece feeding configuration on the apparatus of Goldman for the well known benefits including those described above.

#### ***Response to Arguments***

5. Applicant's arguments filed February 9, 2004 have been fully considered but they are not persuasive.

Applicant argues that

"A significant difference between Applicant's invention and the prior art is its ability to punch holes in a web at predetermined intervals automatically and without the need for the web to be stopped."

It is respectfully submitted that the prior art teaches and/or fairly suggests the claimed invention; that is, the applied prior art teaches and/or suggests all of the claimed limitations. Further, it is respectfully submitted that, while the Examiner is not convinced that structure for punching a moving web is novel or non-obvious, there is nothing in the claims that requires the web to remain in motion, and nothing in the claims that prohibits the stopping of the workpiece. Thus, it is respectfully submitted that the prior art meets the limitations of the claimed invention.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**